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OSHA LIANG L.L.P.
1221 McKinney Street
Suite 2800
Houston, TX 77010

In re Application of :
DAUVOIS, Jean-Luc :
U.S. Application No.: 10/538,725 :
PCT No.: PCT/FR03/50181 :
Int. Filing Date: 16 December 2003 :
Priority Date: 17 December 2002 :
Attorney Docket No.: 11354/091001 :
For: METHOD FOR ACCESS CONTROL IN :
DIGITAL PAY TELEVISION :

DECISION

This decision is in response to the "Renewed Petition Under 37 CFR § 1.47(b)" filed with the United States Designated/Elected Office (DO/EO/US) on 26 February 2007.

BACKGROUND

On 26 July 2006, a decision dismissing applicant's petition under 37 CFR 1.47(b) was mailed. Applicants were given two months to respond with extensions of time available.

On 08 November 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) for failing to respond to the decision mailed 26 July 2006.

On 19 December 2006, applicants requested the withdrawal of the Form PCT/DO/EO/909 mailed 08 November 2006.

On 09 January 2007, a decision vacating the Notification of Abandonment (Form PCT/DO/EO/909) was mailed. Applicant still had time remaining to respond to the decision mailed 26 July 2006.

On 26 February 2007, applicant filed a renewed petition under 37 CFR 1.47(b) which was accompanied by, *inter alia*, a five-month extension and \$2,160.00 fee; two declarations; a legal memorandum and several exhibits and other documentary evidence.

DISCUSSION

As previously indicated, a petition under 37 CFR 1.47(b) must be accompanied

by: (1) the required petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the nonsigning joint inventor (5) evidence showing sufficient proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Items (1), and (6) were satisfied in the initial petition. Item (4) was also accepted; however, there was a question of the address for the nonsigning inventor on the declaration.

Regarding item (2), applicants submitted declarations by Alexandra Dorette and Frederique Dersoir along with copies of letters in the French language (with English translations) and copies of postal receipts also in French without an accompanying English translation.

Ms. Dorette verified the last known address of the nonsigning inventor and states that she sent a copy of the subject application to Mr. Dauvois on 18 October 2006 which was picked up on 23 October 2006. Ms. Dorette then contacted Mr. Dauvois directly via telephone on 02 November 2006 but could not obtain a signature for the declaration. The inventor denied receiving the documents during this telephone conversation but confirmed that he was the inventor for the subject application. Ms. Dorette also states that "Jean-Luc Dauvois indicated that he was not willing to sign any of the Declarations at this time." In his declaration, Mr. Dersoir states that he sent another letter to Mr. Dauvois on 06 February 2006 containing the subject application along with the corresponding declaration and assignment. Mr. Dersoir claims that no response was received.

Despite the lack of translations of the postal receipts, the evidence is sufficient to show that a complete copy of the above-captioned application was forwarded to the nonsigning inventor. Moreover, the lack of a response by Mr. Dauvois and the discussion with Ms. Dorette constitutes a refusal to cooperate as contemplated by section 409.03(d) of the MPEP. Therefore, item (2) is now satisfied.

With regards to item (3), the last known address of the nonsigning joint inventor, Jean-Luc Dauvois is given as:

80 rue des Victimes du Nazisme
Le Mans 72000
France

Petitioner also included a new declaration containing the correct address. This declaration was also executed by the CEO for the 37 CFR 1.47(b) applicant. Item (4) is

complete.

With regards to item (5), petitioner claims sufficient propriety interest using a legal memorandum by Gerard Delile, a French attorney certified as a Specialist in Intellectual Property Law. Section 409.03(f) of the MPEP discusses the use of a legal memorandum and states:

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Mr. Dellile examined several documents which are listed as exhibits 1 - 16. A copy of the pertinent French statute (Article L.611-7) was provided along with discussions of French case law leading to the conclusion that the work of a salaried person extends to all foreign extensions of said patent. Mr. Delile concludes that in his opinion the subject application belongs to Canal+Technologies.

Petitioner also states that Canal+Technologies underwent a name change to Nagra Thomson Licensing on 21 June 2004. A copy of the extracts from the minutes of the Mixed General Meeting of the shareholders of Canal+Technologies was provided with an English translation. This is acceptable proof of the name change.

However, a review of the underlying documents submitted with the petition show that several exhibits were not submitted with an accompanying English translation. Specifically, copies of the letters and memorandum from Canal+Technologies (exhibits 4 - 6, 8 - 9) are requested. Moreover, it has also not been established by a person having firsthand knowledge of the facts that the present invention was made during the time and scope of Mr. Dauvois' employment. It is noted that Exhibit 1 indicates that Mr. Dauvois was employed by Canal+Technologies until 06 September 2002 but that French application (FR02/15978) which PCT/FR03/50181 claims priority to was not filed until 17 December 2002.

For these reasons, item (5) is not yet satisfied.

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CONCLUSION

For the reason discussed above, applicants' petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to timely respond will result in the abandonment of the application. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302